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10/072,289	02/07/2002	Robert Jefferson Jinnett	06285-00307	1992

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/072,289

Applicant(s)

JINNETT, ROBERT JEFFERSON

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This is in response to the applicant's communication filed on February 7, 2002, wherein claims 1-46 are pending.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 33-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 33, the applicant states in the preamble that the invention is directed to a system comprising one or more networks performing the steps of. The preamble does not match the body of the claim.

If this is an apparatus claim, the applicant has failed to provide structure. Furthermore, "network" isn't always a computer network. There are dependent claims that said wherein the network is "a network of insurance brokers, or a network of insurance agents or a network of insurance application service providers". These dependent claim are evidence that the independent claim had within it's scope the meaning of "organization" for the term "network". An "organization" is people with specific responsibilities united for a particular purpose, not interconnected computers. Moreover, a "system" sometimes isn't really a system. The independent claim started out reciting a "system" that comprising one or more networks performing the steps of.

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With no other structure in the independent claim to rely on, the alleged "system" of the independent claim may turn out to be non-statutory for being software per se.

In Claim 34, the applicant states in the preamble that the invention is directed to a communication network. However, in claims 38-42, the applicant states that the communication network includes a network of insurance brokers, insurance agents, and Insurance application service providers.

In Claim 46, the applicant states in the preamble that the invention is directed to in a method for providing electronic access to at least one regulated services and products, a system of protocols is imposed on one or more transactions involving said at least one of regulated services and products, the system comprising the steps of. It is not clear whether this is an apparatus claim, a method claim, or a claim directed to software.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 33-46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under the statute, the claimed invention must fall into one of the four recognized statutory classes of invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter.

For example, as to claim 33, it is not clear what statutory class the applicant's invention is directed to. The preamble states that the invention is directed to *[i]*n as

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*system configured to provide customized insurance services and products in real time, the system comprising one or more networks for performing the steps of.*

The language *configured to provide* would lead one to think the invention is directed to software. As stated above, "system" sometimes isn't really a system. The independent claim started out reciting a "system" that comprising one or more networks performing the steps of. With no other structure in the independent claim to rely on, the alleged "system" of the independent claim may turn out to be non-statutory for being software per se.

As to claim 46, the preamble reads: In a method for providing electronic access to at least one of regulated services and products, a system of protocols is impose on one or more transactions involving said at least one or regulated services and products, said system comprising the steps of:

It is not clear whether this is a system/apparatus claim, a method claim, or a claim directed to software.

Claim 34 is directed to a communications network used for providing real time access to customized insurance services. Furthermore, "network" isn't always a computer network. There are dependent claims that said wherein the network is "a network of insurance brokers, or a network of insurance agents or a network of insurance application service providers". These dependent claim are evidence that the independent claim had within it's scope the meaning of "organization" for the term "network". An "organization" is people with specific responsibilities united for a particular purpose, not interconnected computers

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4. Furthermore, claims 33-46 are rejected under 35 USC 101 for claiming human beings. MPEP 2105 states:

If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 33 is rejected under 35 U.S.C. 102(e) as being anticipated by Buddle et al (US 6,912,502) (hereinafter referred to as Buddle).

Referring to Claim 33:

Buddle discloses a system configured to provide customized insurance services and products in real time, the system comprising one or more networks performing the steps of:

(a) determining a transaction for processing (Figure 1 Step 10 and col. 3, lines 10-25);

- (b) identifying at least one of a user's jurisdiction and a primary jurisdiction relevant to said transaction (Figure 1 (12) col. 1, lines 10-26, col. 3, lines 30-40);
- (c) detecting user input data (col. 2, line 59 thru col. 3, line 9)Figure 1 (14-18);
- (d) applying to said transaction, one or more laws of a jurisdiction identified as said user's jurisdiction or said primary jurisdiction that pertains to said transaction (col. 2, line 59 thru col. 3, line 9; Figure 1 (18)); and
- (e) outputting a transaction result that customizes said user data and application of said one or more laws of a jurisdiction identified as said user's jurisdiction or said primary jurisdiction that pertains to said transaction (Figure 1 (18)).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lederer et al (US 2002/0023109) (hereinafter referred to as Lederer) in view of Dutta et al (US 2003/0061058) (hereinafter referred to as Dutta).

Referring to Claims 1, 4:

Lederer discloses a method of providing electronic access to at least one of services and products that are subject to government regulation, said method comprising the steps of:

(a) providing one or more databases of legal requirements governing said at least one of services and products (Figure 1 (122), [0042]);

(b) providing one or more rules engines (GRCS System (110); [0013]; Figure 2 processing functionality, Figure 8)

(c) creating one or more networks linking each database and rules engine such that each service transaction and each product transaction is customized with the legal requirements relevant to said each service transaction and each product transaction (Figure 1, [0040]); and

(d) outputting a transaction result (Figure 4 (414)).

Lederer does not explicitly disclose establishing a hierarchy of how to apply legal requirements for each said at least one of services and products.

However, Dutta discloses establishing a hierarchy of how to apply legal requirements for each said at least one of services and products [0027,0028].

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the compliance method of Lederer the application of rules set forth in Dutta so that when there are multiple jurisdictions with multiple regulations, by choosing the most restrictive set of interpretations, then all of the rules are followed.



**NOTE:** The Examiner is citing Dutta for the limitation of a hierarchy of how to apply legal requirements. Dutta's priority date is September 26, 2001. The Examiner is aware that the applicant is claiming priority to provisional application no. 60/267,556 with a filing date of 2/9/2001. However, the applicant can only claim priority for what was disclosed in the provisional application. Thus, the limitation of establishing a hierarchy of how to apply legal requirements has a priority date of 2/7/2002.

Referring to Claim 46:

Lederer discloses in a method for providing electronic access to at least one of regulated services and products, a system of protocols is imposed on one or more transactions involving said at least one of regulated services and products, said system comprising the steps of:

(a) identifying one or more legal jurisdictions applicable to each transaction [0038],[0042];

(b) identifying by a choice of law analysis pertinent laws from the identified jurisdictions that are applicable to each transaction [0042];

and

(f) outputting a transaction result (Figure 4 (414)).

Lederer does not explicitly disclose identifying by a preemption analysis which laws substantially preempt other of said pertinent laws, among all remaining laws outside said pertinent laws, ranking of substantially all said remaining laws by level of stringency, and applying, in accordance with said ranking, one or more laws to each

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transaction such that one or more stringently ranked laws applied to a transaction substantially satisfies substantially all less stringently ranked applicable laws.

However, Dutta discloses identifying by a preemption analysis which laws substantially preempt other of said pertinent laws, among all remaining laws outside said pertinent laws, ranking of substantially all said remaining laws by level of stringency, and applying, in accordance with said ranking, one or more laws to each transaction such that one or more stringently ranked laws applied to a transaction substantially satisfies substantially all less stringently ranked applicable laws [0026-0028].

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the compliance method of Lederer the application of rules set forth in Dutta so that when there are multiple jurisdictions with multiple regulations, by choosing the most restrictive set of interpretations, then all of the rules are followed.

**NOTE:** The Examiner is citing Dutta for the limitation of a hierarchy of how to apply legal requirements. Dutta's priority date is September 26, 2001. The Examiner is aware that the applicant is claiming priority to provisional application no. 60/267,556 with a filing date of 2/9/2001. However, the applicant can only claim priority for what was disclosed in the provisional application. Thus, the limitation of establishing a hierarchy of how to apply legal requirements has a priority date of 2/7/2002.

Referring to Claims 2-3:

Lederer discloses providing said legal requirements on a jurisdictional basis [0003],[0038][0042].

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7. Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lederer and Dutta as applied to claim 1 above, and further in view of Hicks et al (2004/0111379) (hereinafter referred to as Hicks).

Referring to Claims 5-10:

Lederer does not disclose configuring each network such that each service transaction and each product transaction is customized according to the legal requirements of a desired jurisdiction relevant to said each said service transaction and each said product transaction, providing security for each database and network to facilitate secure access and data transmission, providing security through a certification authority, authenticating identity of at least one of a user, a file and a transaction, employing technology to protect against interception of any information during data transmission, and providing security that is user-definable.

However, Hicks discloses configuring each network such that each service transaction and each product transaction is customized according to the legal requirements of a desired jurisdiction relevant to said each said service transaction and each said product transaction, providing security for each database and network to facilitate secure access and data transmission, providing security through a certification authority, authenticating identity of at least one of a user, a file and a transaction, employing technology to protect against interception of any information during data transmission, and providing security that is user-definable [0006] [0119-0125], [0126],[0324-0338].

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into regulatory compliance method of Lederer the certification taught in Hicks so as to be able to allow regulated institutions to come together by taking basic technology provided by public key cryptograph and public key infrastructure and combine it with adherence to a common set of operating rules to facilitate electronic commerce.

8. Claims 11-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lederer and Dutta as applied to claim 1 above, and further in view of Buddle et al (US 6,912,502) (hereinafter referred to as Buddle).

Referring to Claims 11-12:

Lederer does not disclose wherein the products and services relate to insurance or finance.

However, Buddle discloses wherein the products and services relate to insurance and finance (col. 2, lines 50-58).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the regulatory compliance method of Lederer services relating to insurance and finance since these are regulated industries which compliance with particular rules in a business context are important.

Referring to Claims 13-32:

Buddle discloses providing one or more query databases of at least one of federal and state laws governing each service and each product on a jurisdiction basis,

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providing one or more query databases of at least one of country and regional laws governing each service and each product on a jurisdiction basis, providing one or more databases of jurisdiction-specific legal requirements governing electronic access and administration for said each service transaction and said each product transaction, providing one or more query databases of jurisdiction-specific licensing requirements governing said each service transaction and said each product transaction, providing one or more query databases of jurisdiction-specific privacy requirements governing said each service transaction and said each product transaction, providing one or more query databases of jurisdiction-specific electronic requirements governing said each service transaction and said each product transaction, providing one or more query databases of jurisdiction-specific advertising requirements governing said each service transaction and said each product transaction, providing one or more query databases of jurisdiction-specific requirements concerning electronic signatures and records governing said each service transaction and said each product transaction, configuring each network to allow use of permitted technologies as desired, and to bar use of prohibited technologies as desired, identifying a governmental jurisdiction governing said each service transaction and said each product transaction, identifying each governmental unit issuing legal mandates governing said each service transaction and said each product transaction, compiling legal requirements applicable to said each service transaction and said each product transaction for each desired jurisdiction, compiling information on said each service transaction and said each product transaction, configuring the network to include access to at least one of individuals and

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entities that participate in providing said each service transaction and said each product transaction, wherein said jurisdiction is a state, wherein said jurisdiction is at least one of a country and member country, wherein said jurisdiction is a region, wherein said jurisdiction is a territory, wherein said jurisdiction is a commonwealth, wherein said jurisdiction is a district (col. 1, lines 11-26; col. 3, lines 10-40; col. 6, lines 47-63)..

9. Claims 34-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buddle et al (US 6,912,502) (hereinafter referred to as Buddle) in view of Dutta et al (US 2003/0061058) (hereinafter referred to as Dutta).

Referring to Claims 34-42:

Buddle discloses a communications network used for providing real time access to customized insurance services, said network comprising:

(a) one or more databases for storing at least one of legal and regulatory data governing an insurance transaction (Figure 7 290 col. 13, lines 35-37) ;

(b) one or more databases for storing at least one of insurance products data and insurance services data (Figure 5B);

(c) one or more rules engines (col. 10, lines 23-32)

(d) one or more processors for processing data transmitted over said network (Figure 7 (255));

and

(e) a data management system for managing integration of insurance

transaction data and rules with said at least one of legal and regulatory data governing said insurance transaction (Figure 7 (280), col. 13, lines 33-35) .

Buddle does not explicitly disclose establishing a hierarchy of how to apply legal requirements for each said at least one of services and products.

However, Dutta discloses establishing a hierarchy of how to apply legal requirements for each said at least one of services and products [0027,0028].

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the compliance method of Lederer the application of rules set forth in Dutta so that when there are multiple jurisdictions with multiple regulations, by choosing the most restrictive set of interpretations, then all of the rules are followed.

**NOTE:** The Examiner is citing Dutta for the limitation of a hierarchy of how to apply legal requirements. Dutta's priority date is September 26, 2001. The Examiner is aware that the applicant is claiming priority to provisional application no. 60/267,556 with a filing date of 2/9/2001. However, the applicant can only claim priority for what was disclosed in the provisional application. Thus, the limitation of establishing a hierarchy of how to apply legal requirements has a priority date of 2/7/2002.

10. Claims 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buddle and Dutta as applied to claim 34 above, and further in view of Hicks et al (2004/0111379) (hereinafter referred to as Hicks).

Referring to Claims 43-45:

Buddle discloses that an insurer must hold a certificate of authority in each state (col. 1, lines 10-26). Buddle does not explicitly disclose security measures enabling said network to be secured, wherein said security measures include at least one of encryption and non-encryption technologies, further including a certification authority for authenticating at least one of an identity of a user, a file and a transaction.

[0006] [0119-0125], [0126],[0324-0338].

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into regulatory compliance method of Buddle the certification taught in Hicks so as to be able to allow regulated institutions to come together by taking basic technology provided by public key cryptography and public key infrastructure and combine it with adherence to a common set of operating rules to facilitate electronic commerce.

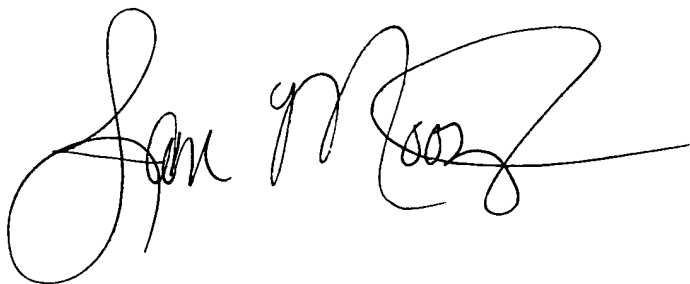


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Jan Mooneyham", with a stylized, flowing script.

Jan Mooneyham  
Patent Examiner  
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